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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/916,629 08/22/97 COBBLEY

C 97-0098

EXAMINER

IM22/0618

STEPHEN A GRATTON
2764 SOUTH BRAUN WAY
LAKEWOOD CO 80228

GALLAGHER, J
ART UNIT PAPER NUMBER

1733

DATE MAILED:

06/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

08/9.6 629

Applicant(s)

Examiner

Gallagher

Group Art Unit

1733

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 19 MARCH 2001
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-22 and 40-44 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-22 and 40-44 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. Claims 42-44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, "a" in line 12 of claim 42 should apparently read "the". In similar vein, it is noted/advanced that the changing of "at" to "in" in claim 1 (lines 7 and 16-17) was unnecessary, i.e. this claim was fine the way it was along this line.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Leo et al. in view of either Nishino or Litke.

4. Claims 1-20 are further rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Leo et al. in view of Mikuni and further in view of either Nishino or Litke.

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5. The foregoing art rejections of paragraphs 3-4 are repeated, with the addition of O'Sullivan et al. as a secondary reference to the statement of each.

6. Claims 21-22 and 40-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Leo et al. in view of Burnett et al. and Gruber et al.

7. Applicants' arguments filed 19 March 2001 have been fully considered but they are not deemed to be persuasive. The foregoing art rejections are adhered to essentially for the reasons of record (see paragraphs 4-7 of the last Office action); further, with each of these rejections, it is the sum total of the teachings of the applied, combined references taken as a whole which is held/seen to render applicants' invention obvious to one of ordinary skill in this art (In re McLaughlin 170 USPQ 209), and therefore applicants' piecemeal attack on the references individually cannot establish unobviousness, since these rejections are based upon a combination of references (In re Mapelsden 141 USPQ 30) i.e. these rejections are not overcome by pointing out that one reference does not contain a particular teaching when the reliance for that teaching was on another reference (In re Lyons 155 USPQ 741), with the following being additionally advanced: In response to applicants' contentions in the amendment (a) Di Leo et al. fairly and clearly provide (N.B. column 3 lines 34-37) for the use of a room temperature curable

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adhesive, which explicit teaching would clearly suggest such use to those of ordinary skill in this art; further along this line, it is noted that (1) a reference disclosure is not limited to its specific illustrative examples, but must be considered as a whole to ascertain what would be realistically suggested thereby to one of ordinary skill in the art (In re Uhlig 153 USPQ 460); and (2) ALL of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art, i.e.

(obviousness may exist) even though the teachings relied upon may be disclosed in the art as non-preferred (or EVEN UNSATISFACTORY) for the intended purpose (In re Boe 148 USPQ 507); ^(B) applicants contend that the applied prior art fails to express an appreciation for the particular reason applicants include a silica filler in their adhesive composition; however, the prior art references to Nishino and Litke both fairly disclose and document the (known and conventional) incorporation of such a filler material in a cyanoacrylate adhesive (and for a beneficial function/result, as set forth in applicants' claim 15 at lines 12-14), such that applicants' motive for carrying out what the prior art teaches cannot serve as a basis upon which to predicate patentability over that which is already within the public domain. In re Heck 216 USPQ 1038; In re Fracalossi 215 USPQ 569; and (c) all of the applied references are held/seen to be sufficiently reasonably pertinent enough to each other to enable

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their proper and tenable combination as set forth in the rejection statements of record; in similar manner, sufficient suggestion/direction/motivation to those of ordinary skill in this art is held/seen to indeed be present in/provided for by the references themselves to enable their proper and tenable combination as set forth in these rejection statements. In conclusion, any differences which might possibly/conceivably exist between the envisioned, claimed invention and the teachings of the applied, combined references of record are held/seen NOT to constitute patentable differences i.e. the gap (if any) between the invention and the teachings of these references being held/seen to be simply not so greater as to render the invention unobvious to one reasonably skilled in this art.

8. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE

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ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

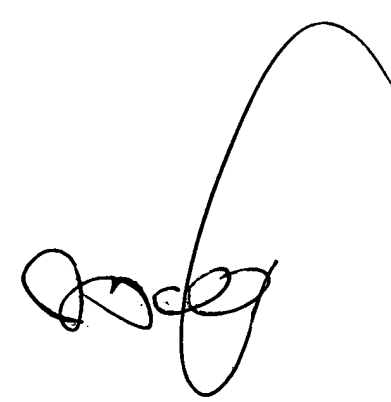
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661/0662.


JJGallagher:cdc

June 5, 2001


JOHN J. GALLAGHER
PRIMARY EXAMINER
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